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**In the Supreme Court of the United States**

OCTOBER TERM, 1983

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NORRIS INDUSTRIES, INC., PETITIONER

v.

INTERNATIONAL TELEPHONE AND TELEGRAPH  
CORPORATION, ET AL.

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*ON PETITION FOR A WRIT OF CERTIORARI TO  
THE UNITED STATES COURT OF APPEALS FOR  
THE ELEVENTH CIRCUIT*

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**BRIEF FOR THE FEDERAL RESPONDENT IN OPPOSITION**

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### **QUESTION PRESENTED**

Whether the court of appeals correctly found that petitioner's wheel covers are not copyrightable because they are useful articles containing no independent and separable works of art.

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## **OPINIONS BELOW**

The opinion of the court of appeals (Pet. App. B-1 to B-13) is reported at 696 F.2d 918. The opinion of the district court (Pet. App. A-1 to A-6) is reported at 212 U.S.P.Q. (BNA) 754.

## **JURISDICTION**

The judgment of the court of appeals was entered on January 24, 1983, and a petition for rehearing was denied on March 18, 1983 (Pet. App. C-1). The petition for a writ of certiorari was filed on May 17, 1983. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

## **STATEMENT**

Petitioner seeks review of the decision of the court of appeals, affirming the judgment of the United States District Court for the Northern District of Florida, that

petitioner's wheel covers are not entitled to copyright protection.

1. The articles involved in this case are covers or hubcaps designed for use on automobile wheels (Pet. App. E-1, E-2). In 1975, petitioner filed an application with the Copyright Office for copyright registration of its first design for a wheel cover. This and a second application were rejected because the subject matter was considered to be uncopyrightable.<sup>1</sup> In a third application, petitioner noted a recent district court decision, *Esquire, Inc. v. Ringer*, 414 F. Supp. 939 (D.D.C. 1976), rev'd, 591 F.2d 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979), in which a refusal to register a lighting fixture was overturned. Petitioner argued, on the basis of this decision, that its application for copyright registration should be allowed (4 C.A. App. 689). In response, the Copyright Office granted registration "in line with [its] policy of resolving doubtful cases in favor of registration" (*id.* at 690-691). Pet. App. A-1 to A-2, B-2.

In 1977, petitioner filed the first of four applications for copyright registration of a second wheel cover design. While these applications were pending, the United States Court of Appeals for the District of Columbia Circuit reversed the lower court decision in *Esquire, Inc. v. Ringer*, 591 F.2d 796 (1978). Petitioner's applications were subsequently rejected because petitioner's wheel covers lacked originality and were useful articles containing no separable works of art. Pet. App. A-2, B-2.

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<sup>1</sup>In a letter accompanying its second application, petitioner argued that while "many wheel covers have a utilitarian function to protect the lug nuts and hub of the wheel from dirt, mud, debris and the like," its wheel covers did not because these substances could pass through the spokes and slots in the back of the wheel cover (4 C.A. App. 654-655). ("C.A. App." refers to the appendix filed in the court of appeals.)

In 1980, petitioner sued respondent International Telephone & Telegraph Corp. (ITT) for patent infringement and infringement of its registered and unregistered copyrights. See 17 U.S.C. (Supp. V) 411(a). The Register of Copyrights entered that suit as a party defendant on the issue of registrability. ITT subsequently filed a declaratory judgment suit to invalidate petitioner's copyrights, and this second action was consolidated with the suit filed by petitioner.<sup>2</sup> ITT and the Register filed motions for summary judgment contending that the wheel covers were uncopyrightable because they were useful articles containing no separable works of art. Pet. App. A2, B-2 to B-3.

2. The district court granted both motions for summary judgment (Pet. App. A-1 to A-6). The court first noted that the refusal of the Copyright Office to register a work will not be overturned unless that refusal constitutes an abuse of discretion (*id.* at A-2). It then recognized that in the Copyright Act of 1976, 17 U.S.C. (& Supp. V) 101 *et seq.*, Congress had codified the longstanding position of the Copyright Office that a useful article is uncopyrightable unless it contains some independent and separable work of art (Pet. App. A-2 to A-4).<sup>3</sup>

In applying the above law to the undisputed facts of this case, the district court found that "the Register's categorization of simulated wire wheel covers as 'useful articles' \* \* \*

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<sup>2</sup>Petitioner's action for infringement of a patent relating to the wire-spoked wheel covers is still pending in the district court.

<sup>3</sup>Sec, *e.g.*, 37 C.F.R. 202.10(c) (1960):

If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of an utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.

[was] logical and proper" because they provide "some degree of protection to lug nuts, brakes, the wheel, and the axle" (Pet. App. A-4). It further found that there was no physically or conceptually separable work of art embodied in the wheel covers because the pattern formed by the spokes cannot exist apart from the wheel cover and "[t]he simulation of a wire wheel, which [petitioner] seeks to copy-right, is not created by the spokes \* \* \*, but by the entire wheel cover" (*id.* at A-6).

3. The court of appeals affirmed the grant of summary judgment (Pet. App. B-1 to B-13). The court of appeals noted that two issues were presented by the case: "whether the wheel covers are useful or ornamental" and, if useful, whether "there is a separable art work that deserves copyright protection" (*id.* at B-1).<sup>4</sup> It held that the district court had correctly found that the wire-spoked wheel covers are useful articles (*id.* at B-9),<sup>5</sup> and then took up the issue of whether the wheel covers contained a separable work of art. The court noted that the wheel covers could be copyrighted if they embodied a work of art that was "either physically severable from the utilitarian article or conceptually severable" (*ibid.*), but found that petitioner's wheel covers met neither test. The court reasoned that "[e]ven if the arrangement of spokes could be identified separately," that arrangement is incapable of separate existence from the utilitarian

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<sup>4</sup>The court of appeals held that the law applicable to this case was the Copyright Act of 1909, 17 U.S.C. 1 *et seq.* (amended by 90 Stat. 2541 *et seq.*), but, like the district court, concluded that the Copyright Act of 1976, 17 U.S.C. (& Supp. V) 101 *et seq.*, recodified existing law regarding copyrightability of useful articles (Pet. App. B-4 to B-5).

<sup>5</sup>The court of appeals concluded that the district court had properly deferred to the Register's determination that petitioner's wheel covers are useful articles. Although a district court should not "simply accept the Register's decision without question," the court of appeals observed that the "uncontradicted evidence and the graphic description of the wheel covers reveals [*sic*] no abuse of administrative discretion by the Register" (Pet. App. B-8 to B-9).



hub cap because "once the spokes are removed from their position the pattern ceases to exist" (*id.* at B-10). The court further held that the legislative history of the Copyright Act of 1976 indicated that conceptually separable works of art include only superfluous designs on useful articles, such as the carving on the back of a chair, that, while not physically severable, constitute independent works of art (Pet. App. B-11 to B-12). The court concluded that petitioner's wire wheel covers "are not superfluous ornamental designs, but functional components of utilitarian articles" and such articles, "no matter how artistically designed, have generally been denied copyright protection" (*id.* at B-12).

#### ARGUMENT

The decision below is correct, does not conflict with any decision of this Court or of any other court of appeals, and does not warrant further review.

1. The court of appeals affirmed the judgment of the district court because it agreed with the district court's findings that petitioner's wheel covers are useful articles that have no features capable of separate identification and independent existence. These conclusions were based upon and are entirely consistent with the decisions of other courts that have considered the question of copyrightability of useful articles. *Mazer v. Stein*, 347 U.S. 201 (1954); *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980); *Esquire, Inc. v. Ringer, supra*; *Eltra Corp. v. Ringer*, 579 F.2d 294 (4th Cir. 1978); *SCOA Industries, Inc. v. Famolare*, 192 U.S.P.Q. (BNA) 216 (S.D. N.Y. 1976); *Ted Arnold Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966).<sup>6</sup>

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<sup>6</sup>In *Mazer v. Stein, supra*; *Ted Arnold Ltd. v. Silvercraft Co., supra*; and *Kieselstein-Cord v. Accessories by Pearl, Inc., supra*, a certificate of registration was issued, and the courts decided in favor of copyrightability. In *Esquire, Inc. v. Ringer, supra*, and *Eltra Corp. v. Ringer,*

There is no discernible difference between petitioner's contentions here and the contention rejected in *Esquire, Inc. v. Ringer, supra*, that a modernistic light fixture is copyrightable.<sup>7</sup> The appellate court did not, as petitioner suggests (Pet. 11-12), deny copyright protection on the ground that its wheel covers are not within the scope of the traditional fine arts. Rather, the court simply concluded that petitioner's wheel covers are useful articles that do not embody a superfluous ornamental design conceptually separable from their utilitarian function (Pet. App. B-12). Cf. *Kieselstein—Cord v. Accessories by Pearl, Inc., supra*, 632 F.2d at 993 (sculptural elements of jewelry are conceptually separable from the subsidiary utilitarian function of jewelry).

2. Despite petitioner's protestations (Pet. 15-23), the courts have uniformly deferred to the Copyright Office's expertise in drawing the line between copyrightable works of art and uncopyrightable useful articles. See, e.g., *Mazer v. Stein, supra*, 347 U.S. at 213. Thus, the court below did not err in according deference to the Copyright Office's determination in this case.<sup>8</sup>

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*supra*, registration was refused, and the courts held the works uncopyrightable. In *Durham Industries, Inc. v. Tomy Corp., supra*, and *SCOA Industries, Inc. v. Famolare, supra*, certificates of registration had been issued, but the courts decided that the copyrights had not been infringed.

<sup>7</sup>In *Esquire, Inc. v. Ringer, supra*, 591 F.2d at 805, the court of appeals addressed and rejected the argument, raised by petitioner (Pet. 13-15), that the Copyright Office's construction of 37 C.F.R. 202.10(c) (1960) runs counter to the principles enumerated in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). The Court denied certiorari in *Esquire* (440 U.S. 908 (1979)), and petitioner has presented no compelling reason for the Court to grant review here.

<sup>8</sup>The uniform deference accorded to the Copyright Office's determinations is demonstrated by the results reached in the decided cases. See note 6, *supra*. Contrary to petitioner's argument (Pet. 19-22), the fact that the Copyright Office registered one of its wheel designs does not

Petitioner's argument (Pet. 17) that principles of administrative law require an evidentiary hearing to determine if its wheel covers are uncopyrightable useful articles is without basis. *Patagonia Corp. v. Board of Governors*, 517 F.2d 803 (9th Cir. 1975), relied upon by petitioner (Pet. 16), is inapposite in the copyright context. In *Patagonia*, the court held that the Board of Governors of the Federal Reserve System could not resolve disputed factual issues by studying affidavits because its governing statute required the Board to make such determinations after notice and hearing. 517 F.2d at 815-816. Neither the Copyright Act of 1909 nor the Copyright Act of 1976, however, requires the Copyright Office to hold an evidentiary hearing to resolve disputed questions of copyrightability. The Copyright Office has traditionally relied upon its examination of the application and accompanying illustrations or specimens of the work to resolve such questions.<sup>9</sup>

3. The court of appeals correctly affirmed the grant of summary judgment in this case. In *Kieselstein-Cord v. Accessories by Pearl, Inc.*, *supra*; *Eltra Corp. v. Ringer*, *supra*; and *Esquire, Inc. v. Ringer*, *supra*, the issue of copyrightability was resolved on summary judgment.<sup>10</sup> The

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furnish a basis for refusing to accord that usual deference to the Copyright Office's final determination in this case. The registration of petitioner's wheel cover was made under the Copyright Office's "rule of doubt" in the wake of the district court ruling in *Esquire*—a ruling that was later reversed on appeal. The registration, therefore, does not demonstrate inconsistency on the part of the Copyright Office, but rather highlights the Copyright Office's continuing efforts to comply with what it perceives to be the dictates of controlling law.

<sup>9</sup>See 17 U.S.C. (Supp. V) 409, 410; H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 155-156 (1976). See also *Esquire, Inc. v. Ringer*, *supra*, 591 F.2d at 806.

<sup>10</sup>The only decision cited by petitioner in which a court refused to decide this issue on summary judgment is *Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc.*, 95 F.R.D. 95 (D. Del. 1982). That court,

uncontroverted evidence in this case, including the photographs reproduced in the petition (Pet. App. E-1, E-2), clearly establish that petitioner's wheel covers afford some protection to the wheels they cover. Petitioner's affidavits merely question the efficiency with which the wheel covers perform this useful function and do not raise a question of material fact. See *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 155 F. Supp. 932, 934-935 (S.D.N.Y. 1957), aff'd in part and rev'd in part on other grounds, 260 F.2d 637 (2d Cir. 1958).<sup>11</sup>

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however, found "no basis \* \* \* for inference that the Copyright Office considered the separability issue in rejecting Trans-World's copyright application" (95 F.R.D. at 98 n.7), and the case is therefore distinguishable from the present litigation where the Copyright Office expressly considered the separability issue. Moreover, subsequent to the Register's intervention in *Trans-World*, the plaintiff voluntarily dismissed its copyright claim, thereby avoiding a ruling on the Register's motion for summary judgment. Thus, *Trans-World* does not establish that expert testimony is essential to the ultimate resolution of the separability issue.

<sup>11</sup>Petitioner's attempt to show error by analogizing the determination below to a determination of obviousness under 35 U.S.C. 103 must also fail (Pet. 24-25). Patents have been properly held invalid for obviousness on summary judgment where the underlying facts relating to the inquiries required by *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), were not in dispute. See, e.g., *Ronel Corp. v. Anchor Lock of Florida, Inc.*, 325 F.2d 889 (5th Cir. 1963), cert. denied, 377 U.S. 924 (1964).

**CONCLUSION**

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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**JULY 1983**